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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/761,450	01/20/2004	Alfred A. Iversen	PMT-0104	3047
7590 Anthony G. Eggink Anthony G. Eggink & Associates 3100 First National Bank Building 332 Minnesota Street Saint Paul, MN 55101			EXAMINER SHAHRESTANI, NASIR	
			ART UNIT 3737	PAPER NUMBER
			MAIL DATE 05/18/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/761,450

Applicant(s)

IVERSEN ET AL.

Examiner

Nasir Shahrestani

Art Unit

3737

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 6/29/2004.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application
- ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-27, 29-31 are rejected under 35 U.S.C. 102(a) as being anticipated by Daniel et al. (U.S. 2002/0133148 A1) herein referred to as “Daniel”.

Daniel teaches a surgical instrument having an elongated body (fig. 1B) having a textured handle member (element 50) and a surgical working portion (element 56) extending therefrom, the instrument comprising said elongated body being formed of an MRI compatible composition (par. 0159) and said handle member having a reference member (hand-piece 68) positioned with respect to the handle member for the hand of the user. Daniel further teaches wherein the a first handle member (element 282) being larger in diameter than a second handle portion (element 284), wherein said reference member positioned with respect to first handle portion (fig. 1B) and wherein said working portion extends from said second handle portion (fig. 20).

Daniel also teaches wherein various connections are formed with the working portion (figures 7A-7H).

Daniel further teaches wherein a first handle portion can be formed of graphite (par. 0174) and a second handle portion can be formed of a polymeric material (par. 0126) and working portion made of titanium which can be treated and anodized (par.0118).

Daniel also teaches wherein said handle member can be formed by use of corrugated or flexible materials having a lower durometer reading (par. 0081; fig. 5).

Daniel teaches wherein said instrument comprises a probe and has an angled distal working portion in a range of 0-90 degrees (fig. 5).

Daniel teaches ports (element 68) configured for aspiration that are made of MRI compatible materials (par. 0075).

Claims 1-3,6, 9, 11 are rejected under 35 U.S.C. 102(e) as being anticipated by Cosman et al. (U.S. 2003/0040743 A1) herein referred to as "Cosman".

Regarding claims 1, 6, Cosman teaches a surgical instrument having an elongated body (fig. 2) having a textured handle member (element 101) and a surgical working portion (element 186) extending therefrom, the instrument comprising said elongated body being formed of an MRI compatible composition (par. 0045) and said handle member having a reference member (electrical connection 104) positioned with respect to the handle member for the hand of the user.

Regarding claims 2, 9, Cosman teaches wherein said MRI compatible composition is selected from the group of compositions consisting of titanium, copper, various forms of stainless steel, aluminum, or other advanced allows (par. 0038).

Regarding claim 3, Cosman further teaches wherein the a first handle member (element 190) being larger in diameter than a second handle portion (element 184), wherein said reference member positioned with respect to first handle portion (fig. 3) and wherein said working portion extends from said second handle portion (fig. 3).

Regarding claim 11, Cosman teaches wherein said working portion has a terminal connecting member (depth stop 185).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Daniel et al. (U.S. 2002/0133148 A1) herein referred to as "Daniel" in view of Yang (U.S. 2004/0054378. Daniel teaches all the limitations of claim 23 but does not teach wherein said handle portion is textured and wherein said texture is provided by parallel grooves in said handle portion. In the same field of endeavor, Yang teaches a set of surgical instruments with angled tip having parallel grooves on the outer surface of a handle portion (par. 0036). It would have been obvious to one of ordinary skill in the art at the time of invention to have modified the apparatus as taught by Daniel and to have incorporated the teachings of Yang in order to facilitate the performance of an operation by providing added friction for the user.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nasir Shahrestani whose telephone number is 571-270-1031.

The examiner can normally be reached on Mon.-Thurs: 7:30-5:00, 2nd Friday: 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Casler can be reached on 571-272-4956. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

NBS
NSS
5/12/2007

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